

REMARKS:

Claims 1-37 are currently pending in the application.

Claims 1-11, 34, and 35 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1-7, 9-18, 20-29, and 31-37 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 6,154,738 to Call (hereinafter “*Call*”).

Claims 8, 19 and 30 stand rejected under 35 U.S.C. § 103(a) over *Call* in view of U.S. Patent No. 7,272,626 to Sahai (hereinafter “*Sahai*”).

Applicant notes with thanks the Examiner’s response of 14 November 2008. Applicant further notes with thanks the Examiner’s withdrawal of the previous objection of Claims 23-33 and 37 and the withdrawal of the previous rejection of Claims 23-33 and 37 under 35 U.S.C. § 101.

Applicant respectfully submits that all of Applicant’s arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner’s rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 101:

Claims 1-11 34, and 35 stand rejected under 35 U.S.C. § 101 as claiming non-statutory subject matter. Applicant respectfully disagrees.

Nonetheless, Applicant has amended independent Claims 1, 34, and 35 to clarify that these Claims are directed to patentable subject matter. Applicant further respectfully submits that these

amendments are not considered narrowing or necessary for patentability. By making these amendments, Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action. Thus, Applicant respectfully requests that the rejection of Claims 1, 34, and 35 under 35 U.S.C. § 101 be reconsidered and that Claims 1, 34, and 35 be allowed.

REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1-7, 9-18, 20-29, and 31-37 stand rejected under 35 U.S.C. § 102(b) over *Call*.

Applicant respectfully submits that the *amendments to Applicant's Claims have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims*. Applicant further respectfully submits that Applicant's amended Claims in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Call*. Thus, Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-28 under 35 U.S.C. § 103(a) over *Call*.

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628,631 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

***Call* Fails to Teach, or Suggest Various Limitations Recited in Applicant's Claims**

For example, with respect to independent Claim 1, this claim recites:

A computer-implemented system for categorizing product data in an electronic commerce transaction, the system comprising:

a global content directory server coupled with one or more seller databases over a network, the global content directory server comprising:

a storage medium stored therein a *data association module* configured to:

access a first product classification schema, the first schema comprising:

a taxonomy comprising a hierarchy of classes categorizing one or more products; and

ontologies associated with one or more of the classes, each ontology comprising one or more product attributes, wherein each of the one or more products is associated with a global unique identifier;

access target data associated with the first schema, the target data organized according to a second product classification schema;

determine one or more classes of the first schema with which at least a portion of the target data is associated based on a comparison between the target data and the product attributes of the ontologies of the first schema or between the target data and values for one or more of the product attributes of the ontologies of the first schema;

associate the at least a portion of the target data with one or more classes of the first schema in response to determining, based on the comparison, the one or more classes of the first schema with which the at least a portion of the target data is associated; and

store the values for one or more of the product attributes of the ontologies of the first schema with which the target data is compared in the one or more seller databases.

(Emphasis Added). In addition, *Call* fails to disclose each and every element of independent Claims 12, 23, 34-37.

Applicant respectfully submits that *Call* fails to disclose, teach, or suggest Claim 1 elements regarding a “***data association module.***”

In particular, the Examiner alleges:

a data association module [e.g., the "Web register" module at Abstract, lines 14-20, Fig(s). 1- 8 and associated texts] coupled with one or more seller database [e.g., the reseller units: 105, 107 at col. 14, lines 43-55] and a global content directory server [e.g., the Internet light weight directory server at Abstract, lines 6-7, the shared sales Internet server at Abstract, line 16, the cross-reference product servers at Abstract, line 18, etc.],

(14 November 2008 Final Office Action, page 4). (Emphasis Original). By contrast, the cited portion of *Call* does not disclose a “***data association module***”, wherein the “***data association module***” is configured to “***access a first product classification schema***,” as recited in Claim 1. (Emphasis added). The question is not simply whether *Call* describes a “***data association module***” but whether *Call* describes a “***data association module***” configured to ***access a first product classification schema***, as recited in Claim 1.

Applicant respectfully directs the Examiner's attention to the cited text of *Call*, on which the Examiner relies:

Methods and apparatus for disseminating over the Internet product information produced and maintained by product manufacturers using existing universal product codes (bar codes) as access keys. A cross-referencing resource, which may take the form of an independent HTTP server, an LDAP directory server, or the existing Internet Domain Name Service (DNS), receives Internet request messages containing all or part of a universal product code and returns the Internet address at which information about the identified product, or the manufacturer of that product, may be obtained. By using preferred Web data storage formats which conform to XML, XLS, XLink, Xpointer and RDF specifications, product information may be seamlessly integrated with information from other sources. A "**web register module can be employed**" to provide an Internet interface between a shared sales Internet server and an otherwise conventional inventory control system, and operates in conjunction with the cross-referencing server to provide detailed product information to Internet shoppers who may purchase goods from existing stores via the Internet.

(Abstract). However, as noted above, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628,631 (Fed. Cir. 1987). As clearly shown in the above-cited portion of *Call*, on which the Examiner relies, *Call does not expressly describe a "data association module"* of any kind. The Examiner relies on Figs. 1-8 and the (Abstract) of *Call* as evidence that *Call* describes the claimed "**data association module.**" (14 November 2008 Final Office Action, page 4). However, *Applicant can find no express description of a "data association module"* in Figs. 1-8 or the (Abstract) of *Call*.

Accordingly, to anticipate Claim 1, *Call* must inherently describe the claimed "**data association module.**"

In that regard, the Examiner states equates the "**data association module**" of Claim 1 with "the '**Web register**' module at Abstract, lines 14-20, Fig(s). 1- 8 and associated texts." (14 November 2008 Final Office Action, page 4). However, *Call* (Abstract) **does not say**, as the Examiner appears to be suggesting, that *Call accesses a first product classification schema comprising a taxonomy* comprising a hierarchy of classes categorizing one or more products and ontologies associated with one or more of the classes, each ontology comprising one or more

product attributes, wherein each of the one or more products is associated with a global unique identifier. *Call* simply states that a "*web register*" module can be employed to provide an Internet interface between a shared sales Internet server and an otherwise conventional inventory control system. (Abstract).

To the extent the Examiner means to argue that the "*web register*" module of *Call* might access a first product classification schema and that Figs. 1-8 and the (Abstract) of *Call* would inherently represent a "*data association module*," "[i]nherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-US.A. Corp., 295 F.3d 1292, 1295 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)). *Applicant is unable to discern from the passages relied upon by the Examiner* that a "*data association module*" is necessarily present in *Call*. While it may be possible, "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939), quoted in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

Furthermore, as noted above, the question is not merely whether *Call* describes a "*data association module*" but whether *Call* describes a "*data association module*" configured to access a first product classification schema, as described in Claim 1.

Accordingly, *Call* does not inherently describe a "*data association module*" as defined in Claim 1.

Thus, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of anticipation of Claim 1 under 35 U.S.C. § 102 with respect to *Call* because *Call* fails to expressly or inherently describe a "*data association module*", as claimed in Claim 1. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish Claim 1 from *Call*.

Office Action Fails to Properly Establish a *Prima Facie* case of Anticipation over *Call*

Applicant respectfully submits that the allegation in the Office Action that *Call* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Call* is considered to anticipate all of the elements in Claims 1-7, 9-18, 20-29, and 31-37. *A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.* MPEP § 2131. (Emphasis Added).

With respect to the subject application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of Applicant's claimed invention is identically shown in *Call*. For example, the Examiner asserts that the “***data association module***”, in Claim 1 is somehow shown in *Call*. (14 November 2008 Final Office Action, page 4). Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion.

Applicant respectfully points out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). Applicant respectfully submits that *the Office Action has failed to establish a prima facie case of anticipation in Claims 1-7, 9-18, 20-29, and 31-37 under 35 U.S.C. § 102 with respect to Call because Call fails to identically disclose each and every element of Applicant's claimed invention, arranged as they are in Applicant's claims.*

Applicant's Claims are Patentable over *Call*

Applicant respectfully submits that independent Claims 12, 23, 34, 36 and 37 are considered patentably distinguishable over *Call* for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent Claims 2-7, 9-11, 13-18, 19-22, 24-29 and 31-33: dependent Claims 2-7 and 9-11 depend from independent Claim 1 and are considered patentably distinguishable over *Call*; dependent Claims 13-18 and 19-22 depend from independent Claim 12

and are considered patentably distinguishable over *Call*; dependent claims 24-29 and 31-33 depend from independent Claim 23 and are considered patentably distinguishable over *Call*. Thus, dependent Claims 2-7, 9-11, 13-18, 19-22, 24-29 and 31-33 are considered to be in condition for allowance for at least the reason of depending from an allowable independent claim.

Thus, for at least the reasons set forth herein, Applicant respectfully submits that Claims 1-7, 9-18, 20-29, and 31-37 are not anticipated by *Call*. Applicant further respectfully submits that Claims 1-7, 9-18, 20-29, and 31-37 are in condition for allowance. Thus, Applicant respectfully request that the rejection of Claims 1-7, 9-18, 20-29, and 31-37 under 35 U.S.C. § 102(b) be reconsidered and that Claims 1-7, 9-18, 20-29, and 31-37 be allowed.

REJECTION UNDER 35 U.S.C. § 103(a):

Dependent Claims 8, 19 and 30 stand rejected under 35 U.S.C. § 103(a) over *Call* in view of *Sahai*. Applicant respectfully traverses the Examiner's rejection of Claims 8, 19 and 30 under 35 U.S.C. § 103(a) over *Call* in view of *Sahai*.

Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Call-Sahai* Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Call* or *Sahai*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" (the "Guidelines").

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;

- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at __, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “*ensure that the written record includes findings of fact* concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “*factual findings made by Office personnel are the necessary underpinnings to establish obviousness.*” (*id.*). Further, “*Office personnel must provide an explanation to support an obviousness rejection* under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that Applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject Application, the Office Action has not shown the *factual findings necessary to establish obviousness* or even *an explanation to support the obviousness rejection* based on the proposed combination of *Call* and *Sahai*, either individually or in combination. The Office Action merely states that “it would have been obvious . . . to *apply the statistical technique disclosed by Sahai into the system of Call.*” (14 November 2008 Office Action, page 7). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Call* and *Sahai*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the*

written record includes findings of fact concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “***obviousness rejection should include***, either explicitly or implicitly in view of the prior art applied, ***an indication of the level of ordinary skill.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill. Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.*** (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant’s invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) between the proposed combination of Call and Sahai, either individually or in combination, and Applicant’s claimed invention, would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that “the combined system will be upgraded to use the well-known statistical correlation techniques to identify portions of the target data...such that

the combined system will provide a more precise response to the user in a decentralized manner.” (14 November 2008 Office Action, page 7). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement *explains why the difference(s) between the proposed combination of Call and Sahai, either individually or in combination, and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.* Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” (*KSR*, 550 U.S. at __, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant's claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Call and Sahai to render obvious Applicant's claimed invention*. The Examiner's unsupported conclusory statements that "it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the statistical technique disclosed by *Sahai* into the system of *Call*," *does not adequately provide clear articulation of the reasons why Applicant's claimed invention would have been obvious*. (14 November 2008 Office Action, page 7). In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Call* and *Sahai*, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines*.

Call and Sahai, Individually and in Combination, Fail to Teach Various Limitations Recited in Applicant's Claims

Applicant respectfully submits that dependent Claims 8, 19 and 30 are considered patentably distinguishable from *Call*. *Call*, as acknowledged by the Examiner, does not teach the unique and novel limitations taught in Claims 8, 19 and 30. This being the case, dependent Claims 8, 19 and 30 are considered patentably distinguishable over *Call*.

With further respect to dependent Claims 8, as mentioned above, dependent Claim 8 depends from independent claim 1, is considered patentably distinguishable over the *Call-Sahai* combination, and is considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 8, 19 and 30 are not obvious over *Call and Sahai*, alone or in combination. Applicant further respectfully

submits that Claims 8, 19 and 30 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 8, 19 and 30 under 35 U.S.C. § 103(a) be reconsidered and that Claims 18, 19 and 30 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$810.00 RCE fee, to Deposit Account No. 500777.** Although Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

16 February 2009
Date

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